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BOARD OF PATENT APPEALS
AND INTERFERENCES

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KLUG

Serial No.: 07/975,905

Filed: November 12, 1992

Atty. File No.: 2355-1-1

For: "REMOTE MULTIPLE-USER
EDITING SYSTEM AND
METHOD"

Group Art Unit: 2307

Examiner: T. Black

APPELLANT'S SUPPLEMENTAL
REPLY BRIEF

ATTN: Board of Patent
Appeals and Interferences

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sirs:

CERTIFICATE OF MAILING

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SHERIDAN ROSS & McINTOSH

BY: Janice Messer

Appellant submits this Supplemental Reply Brief to address the comments provided by the Supervisory Examiner in a Supplemental Answer dated September 29, 1995. See MPEP § 1208.04 ("where good reason to respond is apparent, the examiner may issue a supplemental answer in response to the reply brief"). Although Appellant does not believe that any fees are due, please charge any such fees to Deposit Account No. 19-1970.

Notwithstanding the requirements of MPEP § 1208.04, the "Grounds of rejection" section of the Supplemental Answer provided by the Supervisory Examiner appears in substance to be the same as the "New grounds of rejection" section of the initial Answer provided by the Patent Examiner. That is, in the Supplemental Answer the Supervisory Examiner's application of

Jakobs to the appealed claims, or more specifically the Supervisory Examiner's obviousness analysis, appears in substance to be the same as the Patent Examiner's position set forth in the initial Answer. Appellant's position as to why none of the appealed claims are obvious in view of Jakobs therefore continues to be applicable and should be considered by the Board in rendering its decision.

It appears that the primary difference between the Supplemental Answer and the initial Answer is the addition of the "Response to argument" section on pages 7-11 of the Supplemental Answer. Appellant will limit its Supplemental Reply Brief to these comments provided by the Supervisory Examiner.

An initial point raised by the Supervisory Examiner deals with the Supervisory Examiner's acknowledgement that the text of Jakobs teaches away from the use of PCs, and therefore teaches away from the claims on appeal. In the opinion of the Supervisory Examiner, the alleged deficiency in the Appellant's argument in the Reply Brief as to why this acknowledged teaching away in Jakobs supports the nonobviousness of the appealed claims over Jakobs is that the Appellant "fails to address the nature of Jakobs' teaching away from the instant invention." Supplemental Examiner's Answer, page 7 (September 29, 1995). In the opinion of the Supervisory Examiner, the "shortcomings" of PCs discussed in Jakobs have now been overcome, and as such the Supervisory Examiner takes the position that "it would have been obvious to one of ordinary skill in the art to implement

Jakobs's system using personal computers" Id. It should be noted that Appellant is not aware of any legal authority to support the Supervisory Examiner's position that an express teaching away in a reference may later be obviated.

Representative "deficiencies" of PCs from the Background of the Invention section of Jakobs are as follows:

[W]hile many of these applications can be accomplished with interchangeable application-specific software packages, they often utilize general purpose workstation hardware that is neither powerful enough nor application specific enough to optimize performance.

Jakobs, column 1, lines 33-38.

Prior art single-display workstation are also limited in their lack of display flexibility.

Jakobs, column 1, lines 39-40.

Another limitation of prior art workstations is that they often utilize screen-displayed menu-driven software.

Jakobs, column 1, lines 48-50.

Prior art workstations also fail to address the need for systems integration.

Jakobs, column 1, lines 64-65.

Prior art workstations also lack an integrated real-time full-duplex communication capability. Without this capability they cannot allow dispersed users to edit a single document as a simultaneous group activity.

Jakobs, column 2, lines 9-12.

Prior art workstations also are limited in their ability to display and manipulate true graphic images.

Jakobs, column 2, lines 31-32.

Another limitation of prior art workstations is restricted size of their field of view.

Jakobs, column 2, lines 42-43.

Inherent in current workstations is the inability to modify displayed images by allowing the user to interact directly with the displayed image.

Jakobs, column 2, lines 53-55.

No evidence whatsoever has been offered by the Supervisory Examiner that each of the above-identified deficiencies associated with PCs was overcome prior to Appellant's effective filing date for the appealed claims, much less any support for combining Jakobs with any other prior art as will be discussed

below. Clearly, this is not acceptable and cannot be a proper basis for the Supervisory Examiner's position that the clear teaching away from the use of PCs in Jakobs is no longer a clear basis for conferring a holding of non-obviousness as to the appealed claims. Not only is the lack of support fatal to the Supervisory Examiner's position on the clear teaching away from the appealed claims presented by Jakobs, so too is the fact that a number of these deficiencies have not yet been overcome. Indeed, one of the very problems discussed in the Background of the Invention section of Jakobs, namely that which relates to the editing of a single document by a group of users, was one of the very problems which prompted Appellant's inventive endeavors which resulted in the filing of the above-identified patent application. Specifically, prior to Appellant's invention, there was not a suitable way to allow a group of users to collaboratively edit a single document. Appellant solved this problem through utilization of a host PC with a multi-tasking processing means that both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC to the displays of all of the PCs/terminals within the computer file editing system, wherein the system permits the plurality of users at different remote locations to each see on their associated display the edits being made to the given computer file substantially contemporaneously with the corresponding inputting of these edits.

Apparently, even the Supervisory Examiner is of the opinion that the "problem" of a suitable "collaborative editing system" was not even solved by Jakobs since the Supervisory Examiner has attempted to combine Jakobs with other "prior art" in rejecting Appellant's invention. Not only has the Supervisory Examiner failed to provide any support for making this combination, but this combination is further deficient in that the PC networks that the Supervisory Examiner asserts were in existence at the time of the filing date of the subject patent application do not solve the problem of "collaborative editing" in the manner of Appellant's invention. Indeed, Appellant is aware of no prior art collaborative editing system which utilizes a host PC with a multi-tasking processing means that both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC to the displays of all of the PCs/terminals within the computer file editing system, wherein the system permits the plurality of users at different remote locations to each see on their associated display the edits being made to the given computer file substantially contemporaneously with the corresponding inputting of these edits. Apparently, neither has the Supervisory Examiner since no support has been offered for the position taken in the Supplemental Examiner's Answer. Since the problem of a suitable collaborative editing system addressed by Jakobs in the Background of the Invention was not solved by Jakobs, and

further since this problem has not been addressed in the manner set forth in the appealed claims by any prior art PC of which Appellant is aware, not all of the shortcomings of PCs identified in Jakobs have been overcome. Jakobs continues to teach away from PCs and thus the appealed claims in direct contrast to the position taken by the Supervisory Examiner.

Comments provided by the Supervisory Examiner in the Supplemental Examiner's Answer further supports Appellant's position that Jakobs continues to teach away from the use of PCs and thus the appealed claims. The Supervisory Examiner states on page 8 of the Supplemental Examiner's Answer that the "differences between Jakobs' workstation and the workstations of the prior art were tied to the differences in displays." Supplemental Examiner's Answer at page 8. Jakobs indicates that its workstation has three displays -- one having high resolution black and white capabilities, one for displaying screen display menu commands and for image directory listings, and a third for the display of high resolution color graphics and captured images. No PC has been identified by the Examiner which has multiple displays in the context of Jakobs. Since a deficiency of workstations was noted by Jakobs to be the lack of multiple displays, since Jakobs supposedly overcomes this deficiency, since the Supervisory Examiner heavily relies on this as being a fundamental object of Jakobs, and since the Supervisory Examiner has failed to identify a single post-Jakobs PC which overcomes this deficiency, obviously all of the shortcomings of

PCs discussed in Jakobs have not been overcome. A review of Jakobs by one skilled in the art would surely yield a conclusion by this skilled artisan that Jakobs continues to teach away from the use of PCs. Therefore, Jakobs continues to teach away from the appealed claims such that the appealed claims are not obvious based upon Jakobs.

Additional grounds support the nonobviousness of the appealed claims over Jakobs. Various portions of the text of Jakobs have been referred to by the Examiner in an attempt to read Jakobs on the appealed claims. These "citations" are scattered throughout Jakobs and are no more than isolated statements. These isolated statements from Jakobs are then used by the Examiner in combination with other allegedly "prior art" to be discussed below as support for the obviousness rejection of the appealed claims. Appellant believes that the Supervisory Examiner has impermissibly used hindsight which has long been acknowledged as an improper basis for an obviousness rejection. There is simply no motivation or suggestion by a review of Jakobs in its entirety for one skilled in the art to select the various isolated features identified by the Examiner and to further "modify" this collection of isolated features in any manner which yields Appellant's claimed invention. See Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. (B.N.A.) 543, 550 (Fed Cir. 1985) (examination should not be based upon the obviousness of features, but rather the invention as a whole).

Such a motivation or suggestion must exist in order for the appealed claims to be obvious based upon Jakobs.

The Supervisory Examiner's acknowledged "difference" between the workstation of Jakobs and the workstations of the prior art further supports the conclusion that the appealed claims are not obvious based upon Jakobs. See Supplemental Examiner's Answer, page 8 ("differences between Jakobs' workstation and the workstations of the prior art were tied to the differences in displays"). One skilled in the art simply would not be motivated to "pick and choose" the features from Jakobs which were selected by the Supervisory Examiner to reject the appealed claims. These features are not central to nor even dependent upon the displays of Jakobs nor its single transparent overlay control device. Since the acknowledged emphasis of Jakobs deals with the multiple displays, this supports the conclusion that the only reason the Supervisory Examiner was able to identify the portions of Jakobs used in the rejection of the appealed claims was by a review of Appellant's specification. Utilization of hindsight is impermissible when examining claims and without this hindsight, there is no motivation or suggestion to utilize Jakobs in rejecting the claims on appeal.

As noted above, the rejection of the appealed claims is not based upon Jakobs alone, but is instead based upon a select group of statements from throughout the disclosure of Jakobs in combination with the Examiner's position that "networks" were

known at the time of Appellant's inventive endeavors. Appellant is of course not professing to be the inventor of "networked" PCs and this is not the essence of the claims on appeal. The appealed claims are instead directed to a computer file editing system for a plurality of users at different remote locations which has the following relevant subcombination of features for purposes of addressing the outstanding § 103 rejection:

- 1) the system includes at least one host PC having a multi-tasking processing means which is multifunctional, namely a host PC which both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC to the displays of all of the PCs/terminals within the computer file editing system; and

- 2) a plurality of users at remote locations are able to concurrently view the same portion of the computer file on their respective displays, including any edits made to the subject computer file by at least one of the users, and these edits are provided to all of the displays on a substantially real-time basis such that each user sees the edits substantially contemporaneously with the inputting of the same.

The Examiner's assertion that "PC networks" were known does not equate to a disclosure of a host PC in a computer file editing system including a plurality of PCs/terminals which has multifunctional multi-tasking processing means that both coordinates the execution of file editing operations input by at

least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC to the displays of all of the PCs/terminals within the computer file editing system. The fact that a PC may have been in existence which would be capable of utilizing the appealed claims is not a proper basis for an obviousness rejection unless there is a suggestion or motivation to utilize such a PC in the manner set forth in Appellant's invention. In re Fritch, 23 U.S.P.Q. 2d (B.N.A.) 1780, 1783-84 (Fed Cir. 1992) (although the prior art may be modified in the manner suggested by the Examiner, this does not make the modifications obvious unless the prior art suggests the desirability of the modifications); In re Mills, 16 U.S.P.Q.2d (B.N.A.) 1430, 1432 (Fed. Cir. 1990) (although prior art apparatus may be capable of being modified to run the way of the claimed apparatus, there must be some motivation or suggestion to do so in order for claimed apparatus to be obvious). Since this motivation or suggestion is lacking in this case, this is further basis for the allowability of the appealed claims over the disclosure of Jakobs.

Based upon the foregoing, Appellant respectfully requests a reversal of the Examiner's § 103 rejection of all pending claims and that the above-identified patent application be passed to issuance. Again, Appellant respectfully requests that the original Reply Brief be considered in its entirety since Appellant was merely responding herein to the Supervisory Examiner's rebuttal of Appellant's position taken in the Reply

Brief and not on the substance of the § 103 analysis based upon Jakobs since this position was not changed in the Supplemental Examiner's Answer.

Respectfully submitted,

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